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Paper No. 20

In re Application of :
Sergei Mikhailovich Safronov *et al* : DECISION ON PETITION
Application No. 09/601,913 :
Filed: August 8, 2000 :
Attorney Docket No. V-177 :

On May 6, 2003, petitioners filed a petition to revive this application under 37 CFR 1.137(b), together with the petition fee of \$650.00 and a reply in the form of a "Corrected Brief on Behalf of Appellant." In view of the arguments in the petition that a "Corrected Brief on Behalf of Appellant" previously filed on January 13, 2003 was sufficient to address the examiner's objections to the original appeal brief filed on May 6, 2002, the Office of Petitions has recently referred the petition to the undersigned for consideration as a petition to withdraw the holding of abandonment under 37 CFR 1.181. No fee is required under 37 CFR 1.181.

The petition under 37 CFR 1.181 is dismissed.

The record shows that:

1. This application was finally rejected on September 13, 2001. In the final rejection, claims 1-16 were rejected under 35 USC § 112, first paragraph and claims 1-16 were also rejected under 35 USC § 112, second paragraph. See paper No. 9.
2. In the original appeal brief filed on May 6, 2002, petitioners stated "claims 1-12 and 16 stand or fall together and claims 13-15 stand or fall together." Petitioners also stated that claims 1-12 and 16 "do not necessarily stand or fall with claims 13-15" because the latter claims utilized a particular term and the examiner had raised the use of that term as a separate issue. See paper No. 14.
3. On December 10, 2002, the examiner objected to the appeal brief as failing to comply with 37 CFR 1.192(c)(7) because, *inter alia*, the appeal brief did not set forth reasons why claims 1-12 and 16 did not stand or fall with claims 13-15. See paper No. 15.
4. In reply to paper No. 15, petitioners filed a "Corrected Brief on Behalf of Appellant" on January 13, 2003. See paper No. 16.
5. In paper No. 17 dated March 25, 2003, the examiner dismissed the appeal and held the application to have become abandoned because paper No. 16 allegedly contained claim groupings that did not stand or fall together, but contained no reasons why the groupings did not stand or fall together. See page 2 of paper No. 17.
6. Petitioners then filed the instant petition, accompanied by yet another corrected appeal brief. See paper Nos. 18 and 19, filed May 6, 2003.


It appears to the undersigned that while paper No. 16 in fact contains an explanation of the two claim groupings presented therein, this explanation is stated in the section entitled "Grouping of Claims", and

not in the "Argument" section as expressly required by the regulation. Neither the examiner nor the undersigned has authority to disregard or waive the regulation. Furthermore, the argument is not presented in any detail, but consists of a statement that claims 2-11, 14 and 15 are considered to not stand or fall with claims 1, 12, 13 and 16 because each of claims 2-11, 14 and 15 add further definitional limitations to claims 1, 12, 13 and 16. However, there is no substantive explanation of those definitional limitations and why those definitional limitations is each believed to separately render the claim in which it appears patentable even if a parent claim is held to be unpatentable.

For the foregoing reasons, it is believed that the examiner's holding in which the appeal was dismissed and the application held to have become abandoned was not clearly erroneous, and did not amount to an abuse of discretion. Therefore, there is no basis upon which to grant relief by withdrawing the holding of abandonment.

The application is being returned to the Office of Petitions for action on papers 18 and 19 as a petition to revive under 37 CFR 1.137(b).

PETITION DISMISSED.



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